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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,182	11/30/2000	Niels Mache	450117-02928	5601

20999 7590 08/27/2004

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

LAZARO, DAVID R

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,182

Applicant(s)

MACHE ET AL.

Examiner

David Lazaro

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the amendment filed 06/01/04.
2. Claims 1, 9, 12, 14 and 15 were amended.
3. The Objections to the specification including the title are withdrawn.
4. The Objections to Claims 1 and 14 are withdrawn.
5. The 35 U.S.C. §112, second paragraph, rejection of Claim 1 is withdrawn.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 12 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the claims contain the limitation "wherein messages include a read count and a maximum read count to limit the number of message forwards to the maximum read count value" (as stated from Claim 1). On page 11, the specification does describe a "Read count limitation" which is required when the number of message forwards is limited. Although there is a statement of requirement made, there is no description of how one would limit the number of message forwards and how the read count limitation is involved or interacts as part of

Art Unit: 2155

this limiting. More specifically, there is no description of "limiting the number of message forwards to the maximum read count". On page 16, the specification states that a message can contain a "secure read count" and a "maximum read count". The specification further states that "maximum read count" is intended to be used for "copy protection issues and to control the effect of message chain letters (if wanted)."

However, the intended use does not describe the interaction and involvement of the "maximum read count" in controlling the "effect of message chain letters". Specifically, there is no description of "limiting the number of message forwards to the maximum read count". For these reasons, claims 1, 12 and 15 fail to comply with the written description requirement.

8. Claims 1, 12 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The subject matter not described is in the limitation "wherein messages include a read count and a maximum read count to limit the number of message forwards to the maximum read count value" (from Claim 1). While a message including a read count and a maximum read count is enabled, the functionality of including a read count and a maximum read count "to limit the number of message forwards to the maximum read count value" is not enabled. The specification describes two cases in relating "message forwards" to the properties of a "read count" and a "maximum read

Art Unit: 2155

count". On page 11, the "read count" property is described as a requirement when the number of message forwards is limited. However, the specification offers no description or guidance as to how one would implement the functionality of limiting the number of message forwards. The lack of description as to where or how the "read count" is updated and checked or a how the "read count" correlates to a "message forward" leads to uncertainty as to how one should make the invention. For example, does the display of a message update the "read count" or does the transmission of the message update the "read count". Is another structure present that is keeping track of the number of message forwards or is there a different approach implemented? On page 16, the "maximum read count" is described as intended for use in controlling the effect of message chain letters. While the examiner believes one skilled in the art would realize the connection of "message chain letters" to "message forwards", the examiner does not believe one skilled in the art would be able to make the subject matter as claimed based on this statement of intended use. Furthermore, the specification does not describe how the system as a whole interacts with the "read count" and "maximum read count" to provide the function of limiting the number of message forwards to the maximum read count value. While the "Instant Message Broker" on page 14 uses the "read count" for other functionality, no description is made or guidance offered as to how the broker (or the message gateways) would handle a message forward in terms of limiting the number of message forwards. This also leads to issues of scope in terms of how message forwards coming from outside the system can be accounted for such that the number of messages forwards are limited to a maximum read count value as claimed.

Art Unit: 2155

Prior art such as U.S. Patent 5,740,230 shows message forwards can be limited (Col. 24 lines 40-53), but a read count or a value is not used in making the determination since message forwards are simply either allowed or not allowed. As such, limiting the number of message forward to a maximum read count value is not well known and would not be enabled for that reason. For all these reasons, claims 1, 12 and 15 fail to comply with the enablement requirement.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,740,230 by Vaudreuil (Vaudreuil) in view of U.S. Patent 5,958,005 by Thorne et al. (Thorne).

11. With respect to Claim 1, Vaudreuil teaches a system for transmitting messages over a multimedia network from a sending client to a target client, the messages comprising target client information (Col. 1 lines 52-58), the system comprising: a plurality of message gateways (Col. 7 lines 52-65), each message gateway being configured to receive and transmit over at least one dedicated transfer medium (Col. 7 lines 54-59 and Col. 3 line 66 – Col. 4 line 20), and a message broker (1) (Col. 7 line 65 – Col. 8 line 1; note the examiner is interpreting the 'remainder of the software system'

Art Unit: 2155

on the hub to be the message broker) connected to the message gateways (Col. 7 line 65- Col. 8 line 1) and being provided with a client database (Col. 8 lines 46-51 and Col. 9 lines 61-65), wherein a first message gateway receives a message from a sending client over a first transfer medium (Col. 10 lines 37-41 and Col. 12 lines 21-36) and transmits the message and/or an information extracted thereof to the message broker (1), the message broker (1) automatically selects an appropriate second transfer medium depending on the content of the client database (2) and the supplied message and/or an information extracted thereof (Col. 15 lines 13-20 and Col. 19 lines 49-56), and the message is sent to the target client by means of a second message gateway configured for a transmission over the second transfer medium selected by the message broker (1) (Col. 6 lines 46-65). Vaudreuil also discloses limiting message forwards (Col. 24 lines 40-53). Vaudreuil does not explicitly disclose messages including a read count and a maximum read count. Thorne teaches a read count and a maximum read count (Col. 8 lines 1-10 and Col. 11 lines 5-12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Vaudreuil and modify it as indicated by Thorne such that messages include a read count and a maximum read count to limit the number of message forwards to the maximum read count value. One would be motivated to have this as there is need for controlling the circulation and usage of messages (Col. 2 lines 45-56 of Thorne).

12. With respect to Claim 2, Vaudreuil in view of Thorne teaches all the limitations of Claim 1 and further teaches a common internal message format for the communication

Art Unit: 2155

respectively between the message broker (1) and the message gateways (Col. 6 line 65 – Col. 7 line 9 and Col. 13 lines 2-15 and Col. 19 lines 36-48 of Vaudreuil)

13. With respect to Claim 3, Vaudreuil in view of Thorne teaches all the limitations of Claim 1 and further teaches the message gateways are distributed over the network (See Fig. 1 of Vaudreuil – note gateways are part of the hub functionality).

14. With respect to Claim 4, Vaudreuil in view of Thorne teaches all the limitations of Claim 1 and further teaches the transfer media comprise analog and digital transfer media (Col. 7 lines 49-60 of Vaudreuil).

15. With respect to Claim 5, Vaudreuil in view of Thorne teaches all the limitations of Claim 1 and further teaches at least one message processor (4) provided between the first and the second message gateway for further processing the content of the message to be transmitted (Col. 19 line 66 – Col. 20 line 8 of Vaudreuil).

16. With respect to Claim 6, Vaudreuil in view of Thorne teaches all the limitations of Claim 1 and further teaches the client database (2) comprises addresses of clients (Col. 21 lines 41-46), client preferences (Col. 20 lines 9-11) and/or characteristics of the transfer network to the corresponding target client (Col. 20 lines 11-12 of Vaudreuil).

17. With respect to Claim 7, Vaudreuil in view of Thorne teaches all the limitations of Claim 1 and further teaches the message broker (1) is designed to furthermore perform processing control (Col. 8 lines 22-65 of Vaudreuil) and/or security processing (Col. 28 lines 63-67 of Vaudreuil).

18. With respect to Claim 8, Vaudreuil in view of Thorne teaches all the limitations of Claim 1 and further teaches the message broker (1) is designed to furthermore perform accounting and/or billing (Col. 9 lines 61-65 of Vaudreuil).

19. With respect to Claim 9, Vaudreuil in view of Thorne teaches all the limitations of Claim 1 and further teaches a plurality of message brokers (1, 1') is provided (See Fig. 1 of Vaudreuil – note message brokers are a part of hub functionality).

20. With respect to Claim 10, Vaudreuil in view of Thorne teaches all the limitations of Claim 9 and further teaches at least one message broker (1') being connected with a client database (2') with reduced capacity (Col. 7 lines 61-65 and Col. 8 lines 65-67 of Vaudreuil).

21. With respect to Claim 11, Vaudreuil in view of Thorne teaches all the limitations of Claim 1 and further teaches the messages respectively contain a non-granted encrypted and a granted non-encrypted part (Col. 28 lines 63-67 of Vaudreuil).

22. With respect to Claim 12, Vaudreuil teaches a message broker unit for a distributed multimedia system, characterized in that it is designed to autonomously select an appropriate transfer medium out of a plurality of transfer media for message received from a sending client and to be transferred to a target client (Col. 4 lines 46-49 and Col. 19 lines 49-57), wherein the message broker (1) (Col. 6 lines 46-48) is connected to a client database (2) (Col. 8 lines 46-51 and Col. 9 lines 61-65) and the transfer medium selection is performed depending on target client information and the content of the client database (Col. 20 lines 9-12 and Col. 6 lines 55-59). Vaudreuil also discloses limiting message forwards (Col. 24 lines 40-53). Vaudreuil does not explicitly

disclose messages including a read count and a maximum read count. Thorne teaches a read count and a maximum read count (Col. 8 lines 1-10 and Col. 11 lines 5-12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the message broker unit disclosed by Vaudreuil and modify it as indicated by Thorne such that the messages include a read count and a maximum read count to limit the number of message forwards to the maximum read count value. One would be motivated to have this as there is need for controlling the circulation and usage of messages (Col. 2 lines 45-56 of Thorne).

23. With respect to Claim 13, Vaudreuil in view of Thorne teaches all the limitations of Claim 12 and further teaches the transfer medium selection is performed depending on the target network (Col. 6 lines 55-59 of Vaudreuil), the message type (Col. 20 lines 9-12 of Vaudreuil) and/or client preference contained in the client database (Col. 19 lines 49-56 of Vaudreuil)

24. With respect to Claim 14, Vaudreuil in view of Thorne teaches all the limitations of Claim 12 and further teaches the messages respectively contain a non-granted encrypted and a granted non-encrypted part (Col. 28 lines 63-67 of Vaudreuil).

25. With respect to Claim 15, Vaudreuil teaches a method for sending messages over a multimedia network from a sending client to a target client, the message comprising target client information (Col. 1 lines 52-58), the method comprising the following steps: transmitting the message from the sending client to a message broker (1) over a first transfer medium (Col. 6 lines 46-48), and transmitting the message to the target client over a second transfer medium, wherein the second transfer medium can

Art Unit: 2155

be identical to the first transfer medium (Col. 5 lines 60-66), wherein the message broker (1) selects an appropriate second transfer medium out of a plurality of transfer media depending on the content of a client database (2) (Col. 19 lines 49-56) connected to the message broker (1) (Col. 8 lines 46-51 and Col. 9 lines 61-65) and the target client information (Col. 19 lines 49-56 and Col. 20 lines 9-12). Vaudreuil also discloses limiting message forwards (Col. 24 lines 40-53). Vaudreuil does not explicitly disclose messages including a read count and a maximum read count. Thorne teaches a read count and a maximum read count (Col. 8 lines 1-10 and Col. 11 lines 5-12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Vaudreuil and modify it as indicated by Thorne such that the messages include a read count and a maximum read count to limit the number of message forwards to the maximum read count value. One would be motivated to have this as there is need for controlling the circulation and usage of messages (Col. 2 lines 45-56 of Thorne).

26. With respect to Claim 16, Vaudreuil in view of Thorne teaches all the limitations of Claim 15 and further teaches the transmission of the message from the sending client to the target client is performed essentially in real-time (Col. 24 line 63 – Col. 25 line 3 of Vaudreuil).

27. With respect to Claim 17, Vaudreuil in view of Thorne teaches all the limitations of Claim 15 and further teaches a conversion from the first transfer medium to the second transfer medium is performed depending on the target network (Col. 6 lines 55-

Art Unit: 2155

59 of Vaudreuil), the message type (Col. 20 lines 9-12 of Vaudreuil) and/or client preference contained in the client database (Col. 19 lines 49-56 of Vaudreuil).

28. With respect to Claim 18, Vaudreuil in view of Thorne teaches all the limitations of Claim 15 and further teaches before the transmission to the target client, the content of the message is further processed by digital signing, encryption, watermarking and/or translation (Col. 32 lines 57-64 and Col. 28 lines 63-67 of Vaudreuil).

29. With respect to Claim 20, Vaudreuil in view of Thorne teaches all the limitations of Claim 15 and further teaches the messages respectively contain a non-granted encrypted and a granted non-encrypted part (Col. 28 lines 63-67 of Vaudreuil).

30. With respect to Claim 21, Vaudreuil in view of Thorne teaches all the limitations of Claim 15 and further teaches that when loaded into a computer, it implements a method according to Claim 15 (Col. 7 lines 47-49 of Vaudreuil and Please refer to Claim 15 rejection).

31. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vaudreuil in view of Thorne as applied to claim 15 above, and further in view of U.S. Patent 6,163,796 by Yokomizo (Yokomizo). Vaudreuil in view of Thorne teaches all the limitations of Claim 15 but does not explicitly disclose a lifetime is attributed to each message and transmitting the message only during that lifetime. Yokomizo teaches a message can have a lifetime attributed to it (Col. 6 lines 4-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Vaudreuil in view of Thorne and modify it as indicated by

Yokomizo such that a lifetime is attributed to each message and the message is only transmitted until the expiration of the lifetime. One would be motivated to have this as this provides better efficiency in the messaging system (Col. 2 lines 5-9 of Yokomizo).

Response to Arguments

32. Applicant's arguments, with respect to claims 1, 12 and 15, are directed towards the new limitations "wherein messages include a read count and a maximum read count to limit the number of message forwards to the maximum read count" (from claim 1). The examiner has addressed these limitations based on the interpretation presented in the new grounds of rejection. Furthermore, 35 U.S.C. §112, 1st paragraph issues have been raised regarding these new limitations.

Conclusion

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

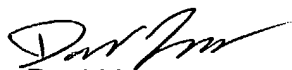
Art Unit: 2155

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 703-305-4868. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Lazaro
August 23 2004


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SUPERVISORY PATENT EXAMINER